

Applicant : Hamburg, et al.
Serial No. : 09/010,801
Filed : January 22, 1998
Page : 12 of 17

Attorney's Docket No.: 07844-235001 / P212

REMARKS

Claims 1-7, 9-25, 27-37, and 39-47 are now pending in the application. Each of independent claims 1, 9, 16, 17, 18, 37, 39, 40, 41, 42, and 43 has been further amended in light of the October 26, 2004, office action. No new matter has been added. Reconsideration and reexamination are respectfully requested in view of the amendments and the following remarks.

As a preliminary matter, the applicant notes that it was established by telephone conference with the Examiner on February 24, 2005, that the Examiner did not receive the portion of applicant's response of July 17, 2004, containing applicant's remarks concerning the previously proposed amendments. Pursuant to the Examiner's recommendation, the applicant re-submits herein those arguments; they are amended slightly in light of the further amendments. The applicant also submits remarks responsive to the additional bases for rejection asserted by the Examiner in the October 26, 2004, office action.

Remarks Submitted July 17, 2004, But Not Received

Claims 1-7, 9-25, 27-37, and 39-47 are now pending in the application. Each of independent claims 1, 9, 16-18, 22, 37, and 39-43 has been amended. No new matter has been added. Reconsideration and reexamination are respectfully requested in view of the amendments and the following remarks.

Claim Rejections 35 USC § 112

The Examiner rejected independent claims 17, 18, 41, and 42 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner specifically indicated that the claims were vague and unclear as to what in the claims were "complete in themselves."

Claims 17, 18, 41, and 42 have been amended to clarify that it is *the document states* that are complete in themselves. The applicants respectfully submit that, as amended, claims 17, 18, 41, and 42 are not indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention and that the Examiner's rejection of these claims is thereby overcome.

Applicant : Hamburg, et al.
Serial No. : 09/010,801
Filed : January 22, 1998
Page : 13 of 17

Attorney's Docket No.: 07844-235001 / P212

Claims 19-21 depend from claim 18. The Examiner indicated that claims 17-21, 41, and 42 will be allowed when the 35 U.S.C. § 112 is overcome. The applicants respectfully submit that amended claims 17-21, 41, and 42 are allowable, and earnestly request that claims 17-21, 41, and 42 be allowed.

Claim Rejections 35 USC § 103

The Examiner rejected independent claims 1, 9, and 39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,828,375 ("Nomura") in view of U.S. Patent No. 6,185,591 ("Baker"). The Examiner rejected independent claims 22 and 43 as being unpatentable over Nomura and Baker in view of U.S. Patent 6,310,630 ("Kulkarni et al."), although the Examiner discussed only Nomura with respect to claim 22. The Examiner did not explain the basis for rejection of independent claims 16, 37, or 40, but such basis is presumed to be similar to the basis for rejection of claims 1, 9, and 39.

Each of these remaining independent claims is now amended to indicate that the pertinent document state is "*complete in itself*" and to indicate the meaning of the phrase "*complete in itself*." In particular, claims 1 and 37 are amended to indicate that the state of the document is "*complete in itself in the sense that earlier document states in the state history of the document can be deleted without adverse affect on later documents states.*" Claims 9 and 39 are amended to indicate that a changed document state is "*complete in itself in the sense that older document states in the state history of the document can be discarded without adverse affect on the added document state.*" Claims 16 and 40 are amended to indicate that each state in the state history is "*complete in itself in that any state in the state history can be deleted without adverse affect on other states.*" Claims 22 and 43 are amended to indicate that each of the states that a document has been in is "*complete in itself in the sense that any earlier state in the history can be deleted without adverse affect on later document states.*"

As discussed in previous correspondence regarding this application, each of these independent claims – namely, claims 1, 9, 16, 22, 37, 39, 40, and 43 – also indicates that the pertinent document states are automatically captured or maintained by, or created by operation of, an application in response to a user command or action.

Applicant : Hamburg, et al.
Serial No. : 09/010,801
Filed : January 22, 1998
Page : 14 of 17

Attorney's Docket No.: 07844-235001 / P212

The applicant respectfully submits that none of the references cited by the Examiner, either alone or in combination, describes or suggests a state history of a document where the document states are "complete in themselves" and are automatically captured or maintained by, or created by operation of, an application in response to a user command or action, as recited by each of these independent claims. For at least this reason, the applicant respectfully submits that independent claims 1, 9, 16, 22, 37, 39, 40, and 43 are not obvious and are allowable.

Allowance of amended independent claims 1, 9, 16, 22, 37, 39, 40, and 43 is therefore earnestly solicited. Each of the remaining claims – claims 2-7, 10-15, 23-25, 27-36, and 44-47 – depends from one of claims 1, 9, 16, 22, 37, 39, 40, and 43, and is allowable for at least the reasons that the claim from which it depends is allowable, as discussed above. For at least such reason, the applicant respectfully submits that dependent claims 2-7, 10-15, 23-25, 27-36, and 44-47 are allowable. Allowance of dependent claims 2-7, 10-15, 23-25, 27-36, and 44-47 is therefore and also earnestly solicited.

Additional Remarks Responsive To Office Action Of October 26, 2004

Claim Rejections 35 USC § 112

In the office action of October 26, 2004, the Examiner rejected each of the independent claims 1, 9, 16-18, 22, 37, and 39-43 under 35 U.S.C. § 112 as based on a disclosure which is not enabling.

The Examiner stated that "[w]hat the cause and effect of the state change and what the state is that is being captured are critical or essential to the practice of the invention, but [] not enabled by the disclosure. It is unclear from Applicants' disclosure what the captured state is, what caused the captured state, and what the effect is of the captured state." The applicants respectfully disagree that such rejection is proper here.

"[I]t is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." *In re Marzocchi*, 439 F.2d 220, 224 (Fed. Cir. 1971); *see also In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993) ("When rejecting a claim under the enablement

Applicant : Hamburg, et al.
Serial No. : 09/010,801
Filed : January 22, 1998
Page : 15 of 17

Attorney's Docket No.: 07844-235001 / P212

requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement.”).

The specification is clear as to what the captured state is, what caused the captured state, and what the effect is of the captured state. As explained in the specification, an application is “a computer program designed for a particular task, and, as is typical, it acts on a central depository called a document, whose content a user creates and edits.” (Specification, page 6, lines 5-8.) For example, “[w]hen a document is opened or newly created, the application generates a snapshot of the document and updates the snapshot or upper region of [a history list]”; in this instance, opening the document is an “interesting operation.” (Specification, page 7, lines 14-27.) In general, “[t]he state of the document is recorded in the state history after the user makes a change to the document that changes the state of the document.” (Specification, page 8, lines 12-14.) The document states are “complete in themselves in the sense that earlier [or older or any] document states in the history can be deleted without adverse affect” on other or later states – a feature that is clearly described, with similar language, in the specification at page 12, lines 1-3. Thus, an effect of capturing a state that is complete in itself is that a user can then navigate the history list by moving forward or backward, or by selecting any item in the list, in which case the corresponding and complete document state “is installed as the current state of the active document.” (Specification, page 15, lines 16-20.)

Given these and additional disclosures in the specification, the applicants respectfully submits that the claimed methods are fully enabled, and no undue experimentation is required to implement the claimed methods in a computer program application.

Withdrawal of the rejection is requested.

Claim Rejections 35 USC § 112

Also in the office action of October 26, 2004, the Examiner rejected each of the independent claims 1, 9, 16-18, 22, 37, and 39-43 under 35 U.S.C. § 112 as being indefinite for

Applicant : Hamburg, et al.
Serial No. : 09/010,801
Filed : January 22, 1998
Page : 16 of 17

Attorney's Docket No.: 07844-235001 / P212

failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner says that "[i]t is unclear and vague from the claim language what Applicants' are really attempting to claim. For example, 'maintaining in a memory a state history of a document.' What is meant by the state history of this document?" The applicants respectfully submit that the meaning of the phrase "state history of a document" is not only clear on its face, but is supported by the disclosure of the specification and the previous arguments of the applicants during the extensive and prolonged prosecution history of this application. See, for example, Specification at page 7, lines 6-30; page 8, lines 12-25.

The Examiner also refers to the language of the second element of claim 1 and says that such language is vague and unclear as written. That element requires: "whenever an interesting operation has occurred, an interesting operation being an operation by the application that changes the state of the document in response to a user command, automatically capturing the state of the document as it exists after the operation and adding the captured state to the state history of the document, the captured state of the document being complete in itself in the sense that earlier document states in the state history of the document can be deleted without adverse effect on later document states."

The language added in the previous amendment, clarifying that the document state is complete in itself in the sense that earlier document states in the state history of the document can be deleted without adverse effect, has been further amended to clarify that the adverse effect is an effect on other document states. (See specification at page 12, lines 1-3.) The applicants respectfully submit that, as amended, the claim language does particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Accordingly, the applicants respectfully submit that the claimed methods are allowable. Withdrawal of the rejection is requested.

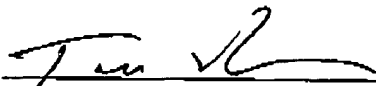
Applicant : Hamburg, et al.
Serial No. : 09/010,801
Filed : January 22, 1998
Page : 17 of 17

Attorney's Docket No.: 07844-235001 / P212

Please charge a one-month extension of time and any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: February 28, 2005



Tamara Fraizer
Reg. No. 51,699

PTO CUSTOMER NO. 021876
Telephone: (650) 839-5070
Facsimile: (650) 839-5071

50257978.doc